

IN THE SPECIFICATION

Please delete the Abstract at page 19 and insert the following:

-- A recording medium comprising a substrate coated with at least one ink receiving layer and at least one protective layer which comprises polymeric particles having film forming temperatures between 60 to 140°C, preferably between 100 to 120°C, and at least one binder. In the related printing method, the printed medium is heated to form a stable image protecting coating. --

R E M A R K S

All, claims pending, namely 17-30 stand rejected as being anticipated by EP 858905 and as obvious over either U.S. Patent Nos. 5,140,339 to Higuma et al or 6,001,463 to Shibahara et al. in view of U.S. Patent No. 6,147,139 to Shaw-Klein; or U.S. Patent No. 5,984,467 to Bodager et al. in view of EP 858905.

ANTICIPATION REJECTION

Claims 17, 19, 25-26 and 29-30 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 858905. Applicants respectfully disagree.

It is axiomatic that "[f]or a prior art reference to anticipate in terms of 35 USC § 102, every element of the claimed invention must be identically shown in a single reference." In re Bond, 910 F.2d 831, 832, 15 USPQ 1566, 1567 (Fed.Cir. 1990).

The claims of the present invention define a receiving medium which comprises a "substrate coated with at least one ink receiving layer and at least one upper protective layer which comprises polymeric particles having film forming temperatures between 60 to 140°C and a binder."

In the process claims of the invention this medium is used in an ink jet printing method. The medium is heated to form a

stable image protecting coating. In contrast to the materials of EP 858905, the image in the invention is "substantially retained within the upper protective layer." Therefore, EP 858905 does not contain every element of the present invention and is not anticipatory of the claims. Accordingly, the Applicants respectfully request that the Examiner's anticipation rejection be withdrawn.

OBVIOUSNESS REJECTIONS

Claims 17 to 30 stand rejected as obvious over either Higuma or Shibahara et al. in view of Shaw-Klein; or Bodager in view of EP 858905.

The Examiner acknowledges that the difference between both Higuma et al. and Shibahara et al. is the requirement in the invention claims of heating the printed image. However, she cites Shaw-Klein as teaching heating the printed image by lamination and when combined with the primary references "arrive at the claimed invention." Applicants respectfully disagree.

It is well-settled that the mere fact that the prior art could be modified to form the invention would not make that modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989); In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed Cir. 1984). It is submitted that the cited art does not teach or suggest the desirability of modifying the ink jet printing methods of Higuma et al. or Shibahara et. al. to incorporate the lamination process disclosed by Shaw-Klein.

As previously discussed the heating step in the invention process produces a stable image protecting coating wherein the image is "substantially retained within the upper protective layer." See Applicants specification at page 4 lines 20-23. This is neither taught nor suggested by Higuma et al. and Shibahara et al. alone or in combination with Shaw-Klein.

Finally, the Examiner has rejected the claims as being obvious over Bodager et al. in view of EP 858905. She acknowledges that Bodager et. al. does not disclose the polymer particles having a film-forming temperature of 60 to 140°C in the protective layer but cites EP 858905 as doing so.

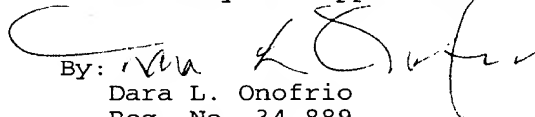
Applicants direct Examiners attention to the arguments presented earlier distinguishing EP 858905. Accordingly, Applicant's assert there is no motivation to combine Bodager with EP 858905. Even if there was, the present invention as claimed wherein the "image is substantially retained within the upper protective layer" is neither taught nor suggested by this combination.

In view of the above arguments, the anticipation and obviousness rejections have been overcome.

Applicants submit that this application is now in condition for allowance. A clean copy of the Abstract in compliance with 37 CFR 1.121(c) is also enclosed. No new matter has been introduced by this Amendment. Reconsideration of this application and allowance of the pending claims are hereby requested, particularly, Claims 1-30.

Respectfully submitted,

Attorney for Applicants

By: 
Dara L. Onofrio
Reg. No. 34,889
233 Broadway - Suite 2702
New York, N.Y. 10279-2799
(212) 791-2950

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